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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/421,422	10/19/1999	PEHR B. HARBURY	8600-0197.30 4130		
24353 7590 01/29/2007 BOZICEVIC, FIELD & FRANCIS LLP		EXAMINER			
1900 UNIVERSITY AVENUE			LIU, SUE XU		
SUITE 200 EAST PALO ALTO, CA 94303			ART UNIT	PAPER NUMBER	
		•	1639		
•			MAIL DATE	DELIVERY MODE	
			01/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief

Application No.	Applicant(s)			
09/421,422	HARBURY ET AL.	HARBURY ET AL.		
Examiner	Art Unit			
Sue Liu	1639			

	Sue Liu	1639	
The MAILING DATE of this communication appe	ars on the cover sheet with the c	orrespondence add	ress
THE REPLY FILED 12/4/06 FAILS TO PLACE THIS APPLICAT	TION IN CONDITION FOR ALLOW	ANCE.	
1. The reply was filed after a final rejection, but prior to or on this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliant time periods:	the same day as filing a Notice of wing replies: (1) an amendment, aff tice of Appeal (with appeal fee) in o	Appeal. To avoid aba idavit, or other evider compliance with 37 C	rce, which FR 41.31; or (3)
a) \square The period for reply expires 3 months from the mailing date			
b) The period for reply expires on: (1) the mailing date of this A no event, however, will the statutory period for reply expire I Examiner Note: If box 1 is checked, check either box (a) or TWO MONTHS OF THE FINAL REJECTION. See MPEP 7	ater than SIX MONTHS from the mailing (b). ONLY CHECK BOX (b) WHEN THE 06.07(f).	g date of the final rejecti E FIRST REPLY WAS F	on. ILED WITHIN
Extensions of time may be obtained under 37 CFR 1.136(a). The date have been filed is the date for purposes of determining the period of ex under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the set forth in (b) above, if checked. Any reply received by the Office late may reduce any earned patent term adjustment. See 37 CFR 1.704(b) NOTICE OF APPEAL	tension and the corresponding amount shortened statutory period for reply orig r than three months after the mailing da	of the fee. The appropr inally set in the final Offi	iate extension fee ce action; or (2) as
 The Notice of Appeal was filed on A brief in complifing the Notice of Appeal (37 CFR 41.37(a)), or any external a Notice of Appeal has been filed, any reply must be filed <u>AMENDMENTS</u> 	nsion thereof (37 CFR 41.37(e)), to	avoid dismissal of th	ns of the date of e appeal. Since
3. The proposed amendment(s) filed after a final rejection,	but prior to the date of filing a brief	will not be entered b	ecause
(a) ☐ They raise new issues that would require further co (b) ☐ They raise the issue of new matter (see NOTE belo	nsideration and/or search (see NO		
(c) They are not deemed to place the application in be appeal; and/or	tter form for appeal by materially re	ducing or simplifying	the issues for
(d) They present additional claims without canceling a NOTE: See Continuation Sheet. (See 37 CFR 1.1		ected claims.	
4. The amendments are not in compliance with 37 CFR 1.1		mpliant Amendment	(PTOL-324).
5. Applicant's reply has overcome the following rejection(s)			(
 Newly proposed or amended claim(s) would be a non-allowable claim(s). 		timely filed amendme	ent canceling the
7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro The status of the claim(s) is (or will be) as follows: Claim(s) allowed:		ll be entered and an e	explanation of
Claim(s) objected to:			
Claim(s) rejected: <u>1,3-10,15 and 16</u> . Claim(s) withdrawn from consideration:	·		
AFFIDAVIT OR OTHER EVIDENCE			
 The affidavit or other evidence filed after a final action, be because applicant failed to provide a showing of good an was not earlier presented. See 37 CFR 1.116(e). 	at before or on the date of filing a N d sufficient reasons why the affidat	otice of Appeal will <u>no</u> vit or other evidence is	ot be entered s necessary and
 The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to showing a good and sufficient reasons why it is necessar 	overcome <u>all</u> rejections under appe	al and/or appellant fa	ils to provide a
10. ☐ The affidavit or other evidence is entered. An explanation REQUEST FOR RECONSIDERATION/OTHER	•		
The request for reconsideration has been considered by See Continuation Sheet.	ut does NOT place the application i	n condition for allowa	nce because:
12. \square Note the attached Information Disclosure Statement(s).	(PTO/SB/08) Paper No(s)		
13. Other:		11.7	
	9	Jis Schret	4
	•	JAMES SCHULTZ, PH.D. PRIMARY EXAMINER	<u>}</u>

Continuation Sheet

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Applicant's proposed amendments would bring new structural and/or functional

limitations into the claims (e.g. Claims 1 and 16), and thus raise new issues such as under 35

USC 112 first paragraph and second paragraph. New searches for both prior art and other issues

for determining patentability would be required.

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As discussed under Item 3, the instant claims as would be amended is not entered due to

consideration of new issues.

The claim rejection under 35 USC §112, first paragraph, as set forth in the previous

Office action, mailed 9/6/06, p. 2+, is maintained for the reason of record.

Applicants mainly argue that it is "irrelevant whether the chemical reaction conditions are

compatible or incompatible with DNA hybridization" (Reply, pp. 6+), and thus the Scope of

Enablement rejection should be withdrawn.

Applicant's argument is not found persuasive, because applicant's assertion relies on the

argument that the compatibility issue between the reaction condition of an organic chemical

reaction, and a DNA hybridization reaction condition is irrelevant. Applicants asserts that the

said two reactions (chemical reaction and DNA hybridization) are carried out separately and not

simultaneously (Rely, p. 7, last para). However, this separation of the different reactions is not a

limitation recited in the claims. In response to applicant's argument that the references fail to

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show certain features of applicant's invention, it is noted that the features upon which applicant

relies (i.e., Chemical reaction separately performed from the hybridization reaction) are not

recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See In re Van Geuns, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the steps of the instant claims read on

a method where the chemical reaction and DNA hybridization are carried out simultaneously.

The claim rejection under 35 USC §112, second paragraph, as set forth in the previous

Office action, mailed 9/6/06, p. 6+, is maintained for the reason of record.

Applicants argue that the proposed claim amendment would overcome the said rejection

under 35 USC 112, 2nd paragraph. However, Applicant's amendments to the claims are not

entered, and the current pending claims as written are unclear and confusing as discussed in the

previous Office action.

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